

Bayer 6708REI-LH
Nit 204-US Yn/yn

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Kozo Shiokawa, et al
Serial No. : 08/254,202
Filed : June 6, 1994
For : NOVEL HETEROCYCLIC COMPOUNDS
Art Unit : 1202
Examiner : D. Daus

Hon. Assistant Commissioner
for Patents
Washington, D. C. 20231

**COMBINED DECLARATION (REISSUE APPLICATION)
AND POWER OF ATTORNEY**

Sir:

Kozo Shiokawa, Shinichi Tsuboi, Shinzo Kagabu, Shoko Sasaki, Koichi Moriya and
Yumi Hattori, the above-named applicants, declare that:

1. Our residences, post office addresses and citizenships are as stated
hereinbelow next to our names.

2. We believe we are the original, first and joint inventors of the subject matter described and claimed in United States Letters Patent (hereinafter "USP") 4,849,432 granted July 18, 1989, and in the application filed June 6, 1994, for reissue of said patent (hereinafter "the reissue application").

3. We hereby state that we have reviewed and understand the contents of the specification of the reissue application and the claims thereof as originally filed and as amended through October 1, 1996.

4. We acknowledge our duty to disclose information which is material to the examination of the reissue application in accordance with Section 1.56 of Title 37, Code of Federal Regulations.

5. We hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application for foreign application or inventor's certificate listed below and have also identified any foreign application for patent or inventor's certificate having a filing date before that of the application of which priority is claimed:

Prior Foreign Application:

<u>Number</u>	<u>Country</u>	<u>Date</u>	<u>Priority Claimed</u>
SHO 61-48629	Japan	March 7, 1986	Yes

Such priority was claimed in USP 4,849,432, now sought to be reissued.

6. We verily believe that said USP 4,849,432 is wholly or partly inoperative or invalid by reason of an inconsistency between claims 1 and 9.

7. We believe the whole or part inoperativeness or invalidity of USP 4,849,432 resides in that claim 1 of USP 4,849,432 claims "A" as only ethylene but patent claim 9 indirectly depends upon claim 1 and embraces "A" as both ethylene and propylene. Thus, there is an inconsistency between the claims which reflects on the validity of patent claim 9. Specifically, Title 35, United States Code, Section 112, paragraph four, requires that "a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed." Patent claim 9 refers to patent claim 8, which, in turn, refers to patent claim 1, but patent claim 9 does not further limit the subject matter of patent claim 1. Accordingly, patent claim 9 appears to be wholly or partly inoperative or invalid in view of Title 35, United States Code, Section 112, paragraph four.

8. The error in patent claim 9 arose without any deceptive intent on our parts. During the original prosecution of the patent, our U.S. patent counsel, Leonard Horn, filed an amendment dated September 26, 1988. In this amendment, he amended original claim 2 to delete the possibility that "A" is trimethylene. Then original claim 2 later became patent claim 1. However, through inadvertence and mistake, he did not make a similar

change in original claim 19. Then original claim 19 became patent claim 9. Accordingly, there developed through inadvertence and mistake an inconsistency between patent claim 1 and patent claim 9 that renders patent claim 9 wholly or partly inoperative or invalid as stated above.

9. On information and belief, the error was discovered by our U.S. patent counsel, Leonard Horn, in Spring 1994. At that time, there were discussions between patent counsel for Nihon Bayer Agrochem K.K., which owns USP 4,849,432, and Bayer Aktiengesellschaft, which is the parent of Nihon Bayer Agrochem K.K., and U.S. patent counsel, Leonard Horn. The discussions concerned what could be done to provoke an interference with USP 4,948,798 granted August 14, 1990, to Laurenz Gsell and assigned to Ciba-Giegy Corporation. Again, on information and belief, it was in connection with those discussions that our U.S. patent counsel, Leonard Horn, had to study the patent claims in great detail, and, in so doing, discovered the error in patent claim 9.

10. On July 9, 1996, during the prosecution of the reissue application, our U.S. patent counsel, Leonard Horn, filed an amendment making patent claim 9 "independent", i.e., deleting the reference to patent claim 8, and, thereby, also the indirect reference to patent claim 1. We are informed that the Examiner accepted this amendment on August 19, 1996. Therefore, patent claim 9, if reissued in this form, clearly would be free from the aforementioned error discussed in original patent claim 9.

11. We, hereby, declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of the application or any patent issuing thereon.

POWER OF ATTORNEY

As named inventors, we hereby appoint the following attorneys to prosecute this reissue application and transact all business in the United States Patent and Trademark Office connected therewith:

Arnold Sprung, Reg. No. 17,323; Nathaniel D. Kramer, Reg. No. 25,350; Ira J. Schaefer, Reg. No. 26,802; and Alan J. Grant, Reg. No. 33, 389, all of 120 White Plains Road, Tarrytown, New York 10591; Leonard Horn, Reg. No. 17,200; Kurt G. Briscoe, Reg. No. 33,141; William C. Gerstenzang, Reg. No. 27,552; and Mark W. Russell, Reg. No. 37,514, all of 660 White Plains Road, Tarrytown, New York 10591, our attorneys with full power of substitution and revocation.

Send Correspondence to:

SPRUNG HORN KRAMER & WOODS
660 White Plains Road
Tarrytown, New York 10591-5144

Direct Telephone calls to:

Leonard Horn, Esq.
(914) 332-1700

Full Name of Inventor : Kozo Shiokawa
Residence : Kanagawa-ken, Japan
Citizenship : Japanese

Oct 7 1996
Date

Kozo Shiokawa
Kozo Shiokawa

Full Name of Inventor : Shinichi Tsuboi
Residence : Tokyo, Japan
Citizenship : Japanese

October 7, 1996
Date

Shinichi Tsuboi
Shinichi Tsuboi

Full Name of Inventor : Shinzo Kagabu
Residence : Gifu-ken, Japan
Citizenship : Japanese

October 9, 1996
Date

Shinzo Kagabu
Shinzo Kagabu

Full Name of Inventor : Shoko Sasaki
Residence : Tokyo, Japan
Citizenship : Japanese

October 16, 1996
Date

Shoko Sasaki
Shoko Sasaki

Koichi Moriya

Yumi Hattori

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : KOZO SHIOKAWA ET AL.
SERIAL NO. : Reissue Application of U.S. Patent 4,849,432,
Issued July 18, 1989
FILED : Herewith
FOR : HETEROCYCLIC COMPOUNDS
ART UNIT : To be assigned
EXAMINER : To be assigned

Box REISSUE

Hon. Assistant Commissioner for Patents
Washington, D.C. 20231

ASSOCIATE POWER OF ATTORNEY

Sir:

The undersigned, KURT G. BRISCOE, being a principal attorney of record in the above-identified reissue application and in related pending reissue application Serial No. 08/254,202, filed June 6, 1994, and in other applications assigned to Bayer Aktiengesellschaft, hereby appoints Bruce S. Londa, Reg. No. 33,531, associate attorney in connection with this and such other applications having full power to prosecute this application and such other applications.

It is understood that prior to making his appearance in any of such other applications, Mr. Londa will file a copy of this original General Associate Power of Attorney and indicate that

the original authorization is contained in this file. Further, the public is authorized to inspect and copy the original authorization in the event that one of the applications containing a copy matures into or is a patent.

Please direct all future correspondence to:

Kurt G. Briscoe
NORRIS McLAUGHLIN & MARCUS, P.A.
220 East 42nd Street
30th Floor
New York, NY 120017

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By


Kurt G. Briscoe
Reg. No. 33,141

220 East 42nd Street
30th Floor
New York, NY 10017
(212) 808-0700

Bayer 6708-REI-LH:gf
Nit 204-US Yn/yn

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Kozo Shiokawa, et al.
Serial No. : (Reissue Application of U.S. Patent
4,849,432, Issued July 18, 1989)
For : NOVEL HETEROCYCLIC COMPOUNDS
Art Unit : 129
Examiner : J. Turnipseed

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

CONSENT OF ASSIGNEE TO FILING
OF APPLICATION FOR REISSUE OF
U.S. PATENT 4,849,432

Sir:

Nihon Tokushu Noyaku Seizo K.K., assignee of the above-identified application, when it issued has by change of name become Nihon Bayer Agrochem K.K. There is submitted herewith a certified cpy of a document evidencing such change of name along with a certified translation thereof. The assignee by virtue of, the assignment recorded on February 24, 1987, at Reel 4694, Frame 892, as evidenced by the Title Report, an order for which accompanies this paper, hereby consents to the filing of the accompanying application for reissue of U.S. Patent 4,849,432.

Respectfully submitted,

NIHON BAYER AGROCHEM K.K.

Date May 19, 1994

By Koichi Tateno
Name: Koichi Tateno
Title: Representative President

Date May 16, 1994

By Isao Ueyama
Name: Isao Ueyama
Title: Director